Claims 8-11, 14-18 and 21 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, the Examiner states "... What is meant by "wherein the second protocol is operably coupled to forward the message to the first protocol along with an indication of the priority level for the message..." Applicants submit that this language is clear on its face, and does not need amendment to particularly point out and distinctly claim this element of the invention. For example, referring to page one of the specification recites that " Many protocol stacks use a message passing architecture for passing protocol messages between protocol layers. In particular, queues are typically used to transfer protocol messages between a particular protocol layer and its adjacent protocol layer..." Thus, at least one method of operably coupling protocol layers is described in the specification, although the present claim should not be limited to this one example, as it is provided for example purposes only.

Accordingly, because the language of the claims is clear and concise, Applicants submit that the rejection under 35 U.S.C. §112, second paragraph should be withdrawn.

Rejections under 35 U.S.C. §103

Claims 1-3, 5-10, 12-17 and 19-22 were rejected under 35 U.S.C.§103(a) as being unpatentable over Baruch (U.S. Patent No: 6,487,206B1).

Baruch, U.S. 6,487,206:

Baruch describes a method of *adjusting an ATM switch local service policy based on a non-ATM protocol service parameter*, the method including the steps of inspecting the payload

of an ATM PDU received at a switch along with at least one VCC to identify a non-ATM PDU

protocol identifier included in the payload, inspecting the payload to identify a non-ATM PDU

service identifier associated with the non-ATM PDU protocol identifier, and selectively adjusting

a local service policy attribute within the switch for the at least one VCC based on the non-ATM

PDU service identifier in accordance with an adjustment value previously associated with the

non-ATM PDU protocol identifier and the non-ATM PDU service identifier. (Baruch, Abstract).

Baruch's invention provides a mechanism for non-ATM PDU's (such as Ethernet frames and

Internet Protocol (IP) packets that have been reformatted into ATM PDUs by the ATM adaption

layer (AAL) to be transmitted between non-ATM networks via an ATM network. (Baruch, col. 1,

lines 20-24). In particular, Baruch describes, at column 4, lines 54-56 "... Once the non-ATM

protocol type and the protocol service identifier are known for the frame, the table 50 is then

consulted for the corresponding CLP override and DLP values. These values are then used

instead of the corresponding attribute fields from table 48 in Fig. 2..."

The Examiner has not provided a Prima-Facie case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First,

there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally,

the prior art reference (or references when combined) must teach or suggest all the claim

limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, and not based on applicant"s

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disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 -

§ 2143.03 for decisions pertinent to each of these criteria.

    Applicants are confused. From a procedural standpoint, the Examiner has not provided

the Applicant with an obviousness rejection. For example, the Examiner has failed to suggest

any modification that should be made, and thus to present any motivation for making that

modification. Applicant's can only guess that that the Examiner is actually putting forth a

novelty argument. Given the unclear aspect of this rejection, Applicants respectfully request that

it be withdrawn, and certainly request that the Examiner refrain from issuing a final office action

in response to Applicants response, as the burden should not be on the Applicant to guess

whether the Examiner views the claims to be anticipated or obvious.

    Applicants further note that there are several places in the rejection where the examiner

simply makes statements that "It would be obvious ...",(page 3 line 24, page 5 line 19) but fails

to state the significance of the obviousness, and in particular, if the Examiner is pointing out that

the cited elements are different than those that are claimed, *why one would be motivated to make*

the substitution. Because the Examiner fails to point out why one would be motivated, a proper

103 rejection has *not* been put forth. The Examiner further goes on to state, at page 9, last

paragraph to page 10, first paragraph that "It would be obvious ... to create a program that would

performs the algorithms .. in both hardware and software; therefore it would be within the skill in

the art to install this program on a computer readable medium..." Such a statement is unfounded

in law. The MPEP specifically states, at section 2143 "...A statement that modifications of the

prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art

at the time the claimed invention was made' " because the references relied upon teach that all

aspects of the claimed invention were individually known in the art is not sufficient to establish a

prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000)..."

Accordingly, for at least the reason that the Examiner has failed to provide any motivation for making a change that is deemed 'obvious', the Examiner has failed to satisfy the criteria for setting forth a prima facie case of obviousness. As such, the rejections under 35 U.S.C. §103 are improper and must be withdrawn.

Combination neither describes nor suggests the claimed invention

Notwithstanding the above, Applicants assert that Baruch neither describes nor suggests the limitations of the claimed invention as amended.

For example, claim 1 now recites "...associating with the first protocol a priority function for assigning a priority level to the message ... invoking the priority function by the second protocol in order to determine the priority level for the message; and forwarding the message *along with an indication of the priority level for the message from the second protocol to the first protocol...*" No such structure is described or suggested by Baruch.

The Examiner states that: "... Baruch teaches a method for forwarding a message between a first protocol and a second protocol (Forwarding messages between a non-ATM protocol or first protocol and ATM protocol or second protocol..."). However, if the Examiner is using these protocols as stated, it is noted that the communication method between these protocols as recited in the claims is not disclosed or suggested by Baruch.

Baruch describes:

"...Switch 40 typically comprises a local service policy table 48 indexed by the VPI/VCI and port address of each VCC established. Table 48 also comprises the cell loss priority (CLP) override value, as well as a delay priority (DLP) value, both of which may be used to determine which queue 44 is to receive the cells for a particular VCC. The CLP and DLP attribute fields in table 48 typically have default values that are initialized during VCC setup based on a negotiated QoS contract. In addition, to table 48, switch 40 also includes the desired CLP override and DLP values associated with each non-ATM protocol identifier and protocol service identifier which are used to dynamically override the attribute fields in table 48... Switch 40 also typically includes a frame parsing table 52 which includes the location within an ATM PCU where a non-ATM protocol identifier and service identifier may be found for each non-ATM protocol frame..." (Baruch, col. 3 line 65-col. 4 line 20.)

Baruch further describes, at col. 4, lines 37-59 :

"... table 52 is consulted for the predetermined location of the non-ATM protocol identifier within the ATM PDU. The payload of the cell is then inspected ... to identify the non-ATM PDU protocol identifier ... processing continues with the non-ATM protocol service identifier being determined by inspecting the payload further ... Once the non-ATM protocol type and the protocol service are known for the frame, table 50 is then consulted for the corresponding CLP override and DLP values..."

In this description, Applicant can find *no messaging communication occurring between the ATM and non-ATM protocol*. Rather, a hardwired substitution of fields within a packet is provided. In addition, Applicant can find no mention of the invocation of any 'priority' function, that was associated with the protocol. Rather, in contrast to 'invoking the priority function in order to determine the priority level for the message' as recited in claim 1, Baruch accesses a table. (Col. 4, line 55). ..Values from the table are used to override Cell Loss Priority (CLP) and Delay Priority (DLP) values for a given QoS that may not be attainable by the new protocol. No mention is made in Baruch of 'forwarding the indication of the priority level for the message' between the two protocols, because Baruch is doing something different from the claimed invention, i.e., Baruch is changing the QoS parameters for non-ATM PDU messages, as opposed

to 'invoking a priority function' to determine 'a priority of a message', and 'forwarding' the message with an indication of the 'priority', as recited in the claims.

The Examiner states, at page 3 line 24 of the office action "Baruch does not particularly call for forwarding a message but teaches forwarding of a non-ATM PDU per Abstract, it would be obvious that forwarding of the non-ATM PDU performs the same function as forwarding a message..." Applicants disagree. Although Baruch does describe the transfer of packets, there is no messaging between protocol layers either described or suggested in Baruch.

"... Forwarding the message by the second protocol to the first protocol (The meaning of this is unclear. The examiner interprets this to mean that the priority associated with the first protocol is incorporated as a priority value in the second protocol...)"

Such an interpretation is over-reaching, and appears to be an effort to read limitations of Baruch into the claimed invention. As clearly mentioned in the specification of the invention, at page 6, lines 13-22 "... the logic invokes the priority function in order to obtain a priority indicator indicating a priority of the protocol message, in step 510. If the protocol indicator indicates that the protocol message is a low priority message ... then the logic forwards the protocol message to the upper layer protocol as a low priority message, in step 516, for example, by placing the protocol message on a low priority message queue..."

Note that in the present invention, the priority indicator is obtained by invoking a priority function. There is not necessarily a direct incorporation of one protocol into another, as suggested by the examiner, because the priority indicator is obtained as a result of the priority function, not simply based on the priority of the first protocol. Thus, Applicants maintain their belief that the claimed invention is patentably distinct from Baruch.

Accordingly, for at least the above reason, claim 1 is patentably distinct over Baruch, and the rejection should be withdrawn. Dependent claims 2-4 and 7 serve to further narrow claim 1 and are therefore patentable with claim 1.

Independent claims 8, 15 and 22 include limitations similar to claim 1 and are allowable for much the same reasons recited above. For example, claim 8 recites "... A device comprising a priority function for assigning a priority level to a message associated with a first protocol, and a second protocol operably coupled to invoke the priority function in order to determine the priority level for the message, *wherein the second protocol is operably coupled to forward the message to the first protocol along with an indication of the priority level for the message...*"

Claim 15 recites "... A program product comprising a computer readable medium having embodied therein a computer program for providing priority forwarding of messages, the computer program comprising ... a priority function for assigning a priority level to a message associated with a first protocol; and a second protocol programmed to invoke the priority function in order to determine the priority level for the message, *wherein the second protocol is programmed to forward the message to the first protocol along with an indication of the priority level for the message...*" Claim 22 recites "... A method for forwarding a message through a layered protocol stack, the method comprising ... receiving the message by a first protocol of the layered protocol stack, invoking by said first protocol a priority function associated with a second protocol of the layered protocol stack in order to determine a priority level for the message; and *forwarding the message by the first protocol to the second protocol according to the priority level for the message...*"

Claims 4, 11 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baruch in view of Wills (U.S. Patent 6,002, 692).

Wills describes a switch architecture for interfacing a high speed communications broadband communication network to a communications fabric having a bandwidth that is a fraction of the high speed broadband network, and the fabric having different packet formats (Wills, Abstract).

The Examiner states, at page 12 of the Office Action "... Baruch does not particularly call for: providing the second protocol with a pointer to the priority function... Wills teaches: providing the second protocol with a pointer to the priority function ... It would be obvious to add the pointer of Wills to the method and system of Baruch in order to build an ATM system with queues..."

The motivation provided by the Examiner is insufficient, as Baruch already has an ATM system with queues, and thus it is unclear as to why Baruch would be motivated to change from the table method to using a pointer. Accordingly, for at least this reason the rejection is improper and should be withdrawn. In addition, the Wills reference, in combination with Baruch, neither describes nor suggests the limitations of the claimed invention. Further, it has been shown above that the parent independent claims related to claims 4, 11 and 18 are nonobvious. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, for the additional reason that claims 4, 11 and 18 depend from non-obvious claims, the claims are patentably distinct over the combination of Baruch and Wills, and the rejection should be withdrawn.

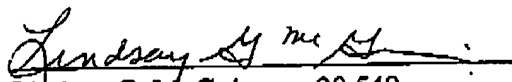Serial No. 09/453,340   - 10 -   Art Unit: 2661

Applicants have made a diligent effort to place the claims in condition for allowance.

However, should there remain unresolved issues that require adverse action, it is respectfully

requested that the Examiner telephone Lindsay McGuinness, Applicants' Attorney at 978-264-

6664 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now

considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

11/10/2003
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